REMARKS

Claims 1-71 are cancelled. Claims 72-80 are pending. Claims 72-80 have been rejected. Claim 72 has been amended. Claim 79 has been amended to remove an extra comma. Claim 72 has been amended. Applicant believes the amendment does not add new matter.

Interview Summary

A telephonic interview was conducted on Feb. 7, 2011 between David Olynick and Examiner Campos. Novelty of the claims over the prior art references were discusses. Examiner Campos suggested a number of limitations to clarify the claims and possibly put the case into condition for allowance.

Claim Objections

Claim 79 has been amended to correct a typographical error and the rejection is believed overcome thereby.

Claim Rejections – 35 U.S.C. § 103

Claims 72-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinomura (U.S. 5,935, 228) in view of Colligan (6, 519, 762) and Suda (U.S. 2004/0123059). The rejection is respectfully traversed.

The present claims describe a memory card that can be configured with a file system that uses 16-bit addressing or 32-bit addressing. A method is provided that can be used to determine how the memory card is configured so that information stored on the memory card can be retrieved by a host device. The method can involve reading a switch position on the memory card under certain circumstances.

Applicant believes the combination does not teach all of the limitations in the pending claims and thus, a *prima facie* case obviousness has not been established. Arguments in this regards are first provided. In addition, Applicant believes the Shinomura teaches away from the use of switch on a PC card. Thus, Applicant believes the combination of Shinomura, Colligan and Suda may be improper.

The Office Communication relies on Shinomura to teach, as recited in claim 72 of the present claims,

"(a) retrieving volume information from an the initial volume stored in a range of addresses that is a part of the contiguous range of addresses that defines the address space;

(b) determining, based on the volume information, whether the initial volume uses a 16-bit addressing or uses less than the 16-bit addressing;

(c) when said determining (b) determines the initial volume uses greater than the 16-bit addressing, by-passing a switch position of the switch, determining the memory card uses 32-bit addressing and communicating to the host via the host controller to use the memory card as a single volume using 32-bit addressing."

The Office Communication maps retrieving volume information to getting information from the "tuple" on a PC Card. Shimomura appears to only described the tuple in two locations. In Col. 3:44-50, Shinomura describes that a client device driver, ascertains by referring to the tuple that it is the driver corresponding to the inserted PC card, learns, from the contents of the tuple, the system configuration required for the PC card, and forwards a request to the Card Service for the assignment of a system resource. In Col. 16:5-10, Shinomura describes that the client device drivers read card attribute information from the tuple in the PC card.

Shinomura is silent in regards to *"determining, based on the volume information, whether the initial volume uses a 16-bit addressing or uses less than the 16-bit addressing,"* as recited in the pending claims. Shinomura only describes the card service receiving the "system configuration required for the PC card" from the tuple but does not say whether the tuple has information indicating whether the initial volume on the PC card uses 16-bit addressing or what type of addressing the PC card uses. Shinomura describes a 16-bit card service that is compatible with a DOS operating mode and a 32-bit card service associated with Windows 95 (see Fig. 3). The 16-bit and 32-bit card services are used to select from among 16-bit drivers and 32-bit drivers, respectively. However, the addressing used by the card service or addressing used by the selected drivers is not an indication of whether the PC card uses 16-bit or 32-bit addressing. The method described in Shinomura is to always select a 16-bit driver if one is available and only use a 32-bit driver "if the PC card is not enabled by any device drivers of the 16-bit mode (Col. 7:48-50, Col. 7:62-64 and Col.8:39-41)." As noted in Fig. 3, if a 16-bit driver is found, then the 32-bit card service is not even notified of the PC card insertion event. Thus, although the Office Communication states the determination related to the addressing used by the initial volume described in the pending claims is taught with respect to Col. 16, Applicant respectfully disagrees with this interpretation of Shinomura.

Further, Shinomura is silent in regards to *"communicating to the host via the host controller to use the memory card as a single volume using 32-bit addressing."* A communication to the host via the host controller of this type does not appear described in Shinomura nor does it appear to be identified in the Office Communication. Therefore, for at least these reasons, Shinomura does not teach or suggest *"(b) determining, based on the volume information, whether the initial volume uses a 16-bit addressing or uses less than the 16-bit addressing; (c) when said determining (b) determines the initial volume uses greater than the 16-bit addressing, by-passing a switch position of the switch, determining the memory card uses 32-bit addressing and communicating to the host via the host controller to use the memory card as a single volume using 32-bit addressing."*

Colligan teaches a method for writing a restore software image to a hard-disk drive (HDD) (see Fig. 4). Colligan teaches a first part 42 of the HDD is used as a buffer zone (see Figs. 2 and 3). In regards to Fig. 4, Colligan teaches first support files are copied to the HDD, a size of the image file is determined, a size of the HDD is determined and then in 62 an inquiry is made into the file system type. Colligan is silent in regards to how this inquiry is performed other than it is performed after support files are already copied to the HDD. In particular, Colligan is silent in regards *"(c) when said determining (b) determines the initial volume uses greater than the 16-bit addressing, by-passing a switch position of the switch, determining the memory card uses 32-bit addressing and communicating to the host via the host controller to use the memory card as a single volume using 32-bit addressing."* A communication to the host via a host controller to use the memory card as a single volume using 32-bit addressing does not appear to be described in Colligan. The Office communication does not appear to point out teaching in regards to what is the host, the host controller and how this communication is taking place Colligan. As described above, this limitation is also not taught in Shinomura. Suda is silent in regards to this limitation and in particular Suda does not appear to describe 32-bit addressing or by-passing a switch position. Therefore, the combination of Shinomura, Colligan and Suda can't be said to teach or suggest the limitations of claims 72-80 and the rejection is believed overcome thereby.

In regards to the limitation in the pending claims, *"(d) when said determining (b) determines that the initial volume uses the 16-bit addressing or uses less than the 16-bit addressing, (1) reading the switch position of the switch on the memory card wherein the switch position of the switch is only used when the host controller determines 16-bit addressing or less is used; (2) determining an address offset for the address space based on upon the switch position wherein the address offset corresponds to one of a plurality of volumes in which the*

memory card is partitioned; (3) communicating to the host device via the host controller to use
*the volume of the memory card indicated by the switch position and the address offse*t." Shinomura and Colligan do not describe the use of a switch in this manner. Colligan is silent in regards to using a switch and, as described below, Shinomura appears to even teach away from using a switch. Suda teaches the use of a switch in which the switch information is always utilized. The use of switch information only when 32-bit addressing is not being used, i.e., the position of the switch is not considered under certain circumstances is not taught in Suda. As is described in paragraph 69 of Suda, the state of the switch is reflected in register 12a by the controller 10. The host device uses whatever information is in this register to determine what storage area to use. Suda does not teach that this information is only used under certain circumstances as is described in the pending claims. Shinomura and Colligan are silent in this regards. Therefore, the combination of Shinomura, Colligan and Suda can't be said to teach or suggest the limitations of pending claims 72-80 and the rejection is believed overcome thereby.

Next, arguments in regards to the combination of Shinomura, Colligan and Suda being improper because Shinomura teaches away from the combination are described. The Shinomura reference and the Colligan reference are silent in regards to a memory card with a switch. Suda describes a switch and the rejection relies on the teachings of Suda to modify the PC cards in Shinomura to include a switch. However, Shinomura teaches away from using a switch. Shinomura teaches the use of a "Plug n Play" (PnP) standard (see Col. 14, line 47, which describes the teachings to follow as a "PNP" support operation). PNP is described in Col. 2: 43-67). In particular, it describes not using jumpers or DIP switches on the PC cards to determine card configuration and performing these operations automatically without the use of manual switches. In particular, Shinomura at Col. 2: 66-67, recites, "As a result, neither jumper nor DIP switches are required for PC cards." Colligan is silent in regards to mechanical switches and Shinomura teaches away from using switches. Therefore, Applicant believes the combination of Shinomura, Colligan and Suda is an improper combination. The MPEP 2145 states it is improper to combine references where the references teach away from the combination.

Conclusion

Applicants believe that all pending claims are allowable and respectfully request a Notice of Allowance for this application from the Examiner. As always, the Examiner is cordially invited to telephone the Applicants' representative to discuss any matters pertaining to this case. Should the Examiner wish to contact the undersigned for any reason, the telephone numbers set out below can be used.

Additionally, if any fees are due in connection with the filing of this Amendment, the Commissioner is authorized to deduct such fees from the undersigned's Deposit Account No. 504481 (Order No. SDK1P017).

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Respectfully submitted,
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